

conditioners; hair lighteners; chelating agents; cell turnover enhancers; coloring agents;  
pigments; sunscreens and mixtures thereof.

*C. 12*  
Please cancel claim 10 without prejudice or disclaimer.

### **REMARKS**

#### **I. Status of the Claims**

Claims 1-9 and 11-20 are pending in this Application. Support for the amendment to claim 1 can be found in original claim 10. Accordingly, no new matter has been introduced by this Amendment.

Attached hereto is a marked-up version of the changes made to the specification and claims by the current amendment. The attached page(s) is/are captioned "Version with markings to show changes made."

#### **II. The Rejection Under 35 U.S.C. §102(b)**

The Examiner has rejected claim 1 as allegedly anticipated by Herman. The Examiner relies upon Herman as disclosing the "that the basic components of ringing gel formulations are oil, water, a surfactant, and a cosurfactant." The Examiner also argues that the disclosure of carbomer at page 24 reads on the benefit agent of Applicants claimed invention. Applicants respectfully traverse this rejection.

As amended, the claimed invention relates to a method of depositing a benefit agent on a keratinous surface, said method comprising topically applying to said surface an effective amount of a ringing gel composition comprising (a) a surfactant phase ; (b) an oil phase; and (c) a benefit agent; wherein the benefit agent is selected from the group consisting of vasoconstrictors, collagen enhancers, anti-edema agents, depigmentation agents; reflectants; detangling/wet combing agents; film forming polymers; humectants; amino acid agents; antimicrobial agents; allergy inhibitors; anti-acne agents; anti-aging agents; anti-wrinkling agents, antiseptics; analgesics; antitussives; antipruritics; local anesthetics; anti-hair loss agents; hair growth promoting agents; hair growth inhibitor agents; antihistamines; antiinfectives; inflammation inhibitors; anti-emetics; anticholinergics; vasoconstrictors;

vasodilators; wound healing promoters; peptides, polypeptides and proteins; deodorants and anti-perspirants; medicament agents; skin emollients and skin moisturizers; skin firming agents, hair conditioners; hair softeners; hair moisturizers; vitamins; tanning agents; skin lightening agents; antifungals; depilating agents; shaving preparations; external analgesics; perfumes; fragrances counterirritants; hemorrhoidals; insecticides; poison ivy products; poison oak products; burn products; anti-diaper rash agents; prickly heat agents; make-up preparations; vitamins; amino acids and their derivatives; herbal extracts; retinoids; flavonoids; sensates; anti-oxidants; skin conditioners; hair lighteners; chelating agents; cell turnover enhancers; coloring agents; pigments; sunscreens and mixtures thereof.

As the Examiner is well aware, a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. See M.P.E.P. § 2131. Here, Herman fails to teach or suggest ringing gel compositions comprising a benefit agent as described in claim 1. Accordingly, Herman fails to anticipate claim 1. Applicants, therefore, respectfully request withdrawal of this rejection.

### **III. The Rejections Under 35 U.S.C. §103**

#### *A. The Rejection of Claims 2, 3, 10-17 and 20*

The Examiner has rejected claims 2, 3, 10-17 and 20 as allegedly unpatentable over Herman in view of U.S. Patent No. 6,046,145 ("Santora et al."). Recognizing that Herman fails to teach the limitations of claims 2, 3, 10-17 and 20, the Examiner relies upon Santora et al. Specifically, the Examiner argues that because Santora et al. teach shampoo compositions comprising anionic, amphoteric and anionic surfactants, fragrances, coloring agents, chelating agents, and from about 58.22 to about 70.5% water, it would be obvious to one of ordinary skill in the art to incorporate these ingredients in the ringing gel broadly disclosed by Herman. Applicants respectfully traverse this rejection.

Herman fails to teach or suggest Applicants' claimed method of depositing a benefit agent on a keratinous surface. There is nothing in the teachings of Herman that would provide one of ordinary skill in the art with the expectation that the ringing gel composition broadly disclosed by Herman could be used to deposit benefit agents to keratinous surfaces. As discussed in the Specification, Applicants have discovered that ringing gel compositions according to the invention may be used to deposit benefit agents onto keratinous substrates, such as the skin, hair and nails of a human or animal, even after rinsing the composition off

of the skin. This finding of a "2 in 1" composition, where the product cleanses as well as leaves a particular benefit agent behind is novel, as one would expect that the cleansing surfactants present in the composition would remove all of the benefit agent from the surface.

The Examiner argues that Herman teaches the application of the ringing gel in upscale skin care compositions, which, upon topical administration, inherently deposits the cosmetic active agents therein on skin. First, Applicants note that Herman fails to teach the benefit agents used in Applicants' claimed invention, much less, their deposition on the skin. Second, while Herman does mention the use of ringing gels in upscale skin care applications, he urges that the reason the ringing gels are used is because they make products into which they are incorporated "attractive" in terms of feel and "clarity." Herman does not disclose, teach or suggest using ringing gel compositions to deliver any benefit agent, especially compositions that will not only cleanse but also leave a particular benefit agent behind, even after rinsing the composition off of the hair, skin or nails.

Santora does not remedy this deficiency. The Examiner argues that "one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references" and that "the fact that Santora is silent as to the application of its surfactants in ringing gel composition does not necessarily negate the obviousness that a skilled worker would have chosen the known surfactants with specific beneficial cosmetic properties for the surfactants in Herman's ringing gel compositions."

Applicants recognize that the references relied upon by the Examiner must be viewed in combination. However, the mere fact that references can be combined or modified does not render the resultant combination obvious **unless the prior art also suggests the desirability of the combination**. See M.P.E.P. § 2143. Here, the Examiner has failed to provide any teaching or suggestion in either of Herman or Santora et al. that would provide one of ordinary skill in the art with the motivation to incorporate the ingredients taught by Santora et al. into the ringing gel compositions disclosed by Herman.

Accordingly, Applicants respectfully submit that neither Herman nor Santora et al., taken alone or in combination render the present claims obvious for the following reasons: (1) there is no suggestion or motivation in either of Herman or Santora et al. to modify the compositions of Herman as suggested by the Examiner; (2) even if one of ordinary skill in the art was somehow motivated to incorporate the ingredient taught by Santora et al. into the Herman ringing gel compositions, there is nothing in the teachings of Herman or Santora et

al. that would provide a reasonable expectation that such a modification of the Herman ringing gel compositions would be successful; and (3) even if the references were combinable as suggested by the Examiner, all the claim limitations are not taught or suggested since neither Herman nor Santora et al. teach or suggest Applicants' claimed method of depositing a benefit agent on a keratinous surface. Therefore, the rejection should be withdrawn.

*B. The Rejection of Claims 4-9*

The Examiner has rejected claims 4-9 as allegedly unpatentable over Herman and Santora et al. as applied to claims 1-3, 10-17 and 20 and further in view of U.S. Patent No. 4,940,577 ("Greenberg et al.").

The Examiner relies upon Greenberg et al. for teaching the specific oil phase recited by claims 4-9. Specifically, the Examiner argues that it would have been obvious to one of ordinary skill in the art to modify the ringing gel composition taught by Herman by incorporating certain ingredients taught by Santora et al. and further modify the composition by incorporating specific esters taught by Greenberg et al. because of "the expectation to have produced a clear microemulsion skincare composition with a smooth and non-tacky feel."

Greenberg et al. fails to remedy the deficiencies of Herman and Santora as set forth above. There is nothing in the teachings of Greenberg et al., Herman and Santora, taken alone or in any combination, that would provide one of ordinary skill in the art with the motivation to incorporate the ingredients taught by Santora et al. and Greenberg et al. into the ringing gel compositions disclosed by Herman. As discussed above, the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. Here, the Examiner has failed to provide the requisite motivation for the combination. Further, since neither Santora et al. nor Greenberg et al. disclose ringing gel compositions, Applicants respectfully submit that there would not be a reasonable expectation that the ingredients taught by Santora et al. and Greenberg et al. could successfully be incorporated into ringing gel compositions. Accordingly, Applicants respectfully submit that the Examiner has failed to establish a *prima facie* case of obviousness for the following reasons: (1) there is no suggestion or motivation in any of the references relied upon by the Examiner to modify the compositions of Herman as suggested by the Examiner; (2) even if one of ordinary skill in the art was somehow

motivated to incorporate the ingredient taught by Greenberg et al. and Santora et al. into the Herman ringing gel compositions, there is nothing in the teachings of Greenberg et al., Herman or Santora et al., taken alone or in combination, that would provide a reasonable expectation that such a modification of the Herman ringing gel compositions would be successful; and (3) even if the references were combinable as suggested by the Examiner, all the claim limitations are not taught or suggested since none of the references teach or suggest Applicants' claimed method of depositing a benefit agent on a keratinous surface. Accordingly, Applicants respectfully request that this rejection be withdrawn.

*C. The Rejection of Claims 18 and 19*

The Examiner has rejected claims 18 and 19 as allegedly unpatentable over Herman in view of Piechota.

The Examiner relies upon Piechota for teaching a method for treating acne and the specific oil phase recited by claims 18 and 19. Piechota relates to topical compositions which can be applied as a relatively low viscosity flowable liquid and which will quickly, upon contact with the warm surface of an animal, turn into a relatively high viscosity, essentially non-flowable, gel. Accordingly, the compositions taught by Piechota are distinct from the ringing gel compositions disclosed by Herman. Indeed, Piechota specifically teaches the disadvantages of compositions in the form of a gel prior to use. See col. 1, line 14 – col. 2, line 15.

It is the Examiner's position that it would have been obvious to one of ordinary skill in the art "to have modified the Herman's composition by adding retinoids or antimicrobial agents and used it to treat acne, as taught by Piechota, because of the expectation of successfully producing a ringing gel composition that may be used for acne treatment." Applicants respectfully traverse. Why would one of ordinary skill in the art be motivated to incorporate the anti-acne ingredients taught by Piechota into the ringing gel compositions taught by Herman when Piechota specifically teaches the disadvantage of compositions that are in the form of gels prior to use when applying active ingredients to humans and animals?

The Examiner states that Piechota discloses ringing gel compositions. Applicants respectfully disagree. Applicants remind the Examiner that references must be considered in their entirety. Clearly, Piechota is directed to compositions that are not in gel form until after applied to a desired situs. See, for example, col. 2, lines 11-15. Applicants have pointed out

that the only disclosure in Piechota of ringing gels is at col. 3, lines 59-66. Here, Piechota is evaluating the effect of different poloxamers. Specifically, Piechota teaches that Pluronic F127 has the ability to form a ringing gel and as such “would not lead one skilled in the art to employ Pluronic F127 to meet the objects of this invention in that such teachings are totally inimical to the objects of this invention; **it is taught that the result is a gelled solution at room temperature i.e. one that cannot be filled, stored or dispensed as a flowable liquid.**” See col. 3, line 66- col. 4, line 5 (emphasis added). Clearly, Piechota teaches away from compositions in the form of a gel prior to use.

The Examiner argues that “the disadvantage of using poloxamers is irrelevant in adding acne agents or antibacterial agents into the ringing gel of Herman for topical use” and that “the specific types of poloxamers referred by Piechota, Poloxmer 407, is neither a required limitation in instant claims or disclosed in Herman.” Applicants respectfully submit that the Examiner has misunderstood Applicants’ arguments. Applicants have pointed to this Example as evidence that Piechota teaches that composition for topical application in the form of gels prior to use are not desirable due to flow problems. Clearly, one of ordinary skill in the art, armed with the disclosure of Piechota, would expect that the gel compositions taught by Herman would not be useful for delivering active ingredients, such as anti-acne agents, due to the fact that they are in the form of a gel. Thus, Piechota fails to provide the requisite motivation for incorporating an anti-acne active into the compositions of Herman. Indeed, Piechota specifically teaches away from such a modification due to flow problems. Accordingly, one of ordinary skill in the art would not have been motivated to combine the teachings of Piechota with the teachings of Herman. Applicants, therefore, respectfully request that this rejection be withdrawn.

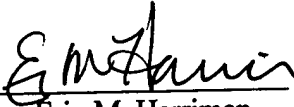
## V. Conclusion

For the reasons set forth above, Applicants respectfully request withdrawal of all outstanding rejections. If the Examiner feels that a discussion with Applicants’ representative would be helpful in resolving the outstanding issues, the Examiner is invited to contact Applicants’ representative at the number provided below.

If there are any other fees due in connection with the filing of this response, please charge the fees to our Deposit Account No. 10-0750/JBP-529/EMH. If a fee is required for an

Extension of time 37 C.F.R. § 1.136 not accounted for above, such an extension is requested and the fee should also be charged to our Deposit Account 10-0750/JBP-529/EMH.

Respectfully submitted,

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**VERSION WITH MARKINGS TO SHOW CHANGES MADE**

**In the Claims:**

1. (Amended) A method of depositing a benefit agent on a keratinous surface, said method comprising topically applying to said surface an effective amount of a ringed gel composition comprising (a) a surfactant phase ; (b) an oil phase; and (c) a benefit agent; wherein the benefit agent is selected from the group consisting of vasoconstrictors, collagen enhancers, anti-edema agents, depigmentation agents; reflectants; detangling/wet combing agents; film forming polymers; humectants; amino acid agents; antimicrobial agents; allergy inhibitors; anti-acne agents; anti-aging agents; anti-wrinkling agents, antiseptics; analgesics; antitussives; antipruritics; local anesthetics; anti-hair loss agents; hair growth promoting agents; hair growth inhibitor agents; antihistamines; antiinfectives; inflammation inhibitors; anti-emetics; anticholinergics; vasoconstrictors; vasodilators; wound healing promoters; peptides, polypeptides and proteins; deodorants and anti-perspirants; medicament agents; skin emollients and skin moisturizers; skin firming agents, hair conditioners; hair softeners; hair moisturizers; vitamins; tanning agents; skin lightening agents; antifungals; depilating agents; shaving preparations; external analgesics; perfumes; fragrances counterirritants; hemorrhoidals; insecticides; poison ivy products; poison oak products; burn products; anti- diaper rash agents; prickly heat agents; make-up preparations; vitamins; amino acids and their derivatives; herbal extracts; retinoids; flavenoids; sensates; anti-oxidants; skin conditioners; hair lighteners; chelating agents; cell turnover enhancers; coloring agents; pigments; sunscreens and mixtures thereof.
20. (Amended) A method of cleansing and delivering a benefit agent to hair, skin or nails of a mammal, comprising topically applying to a desired location an effective amount of a ringed gel compositions comprising (a) surfactant phase; (b) an oil phase; and (c) a benefit agent; wherein the benefit agent is selected from the group consisting of vasoconstrictors, collagen enhancers, anti-edema agents, depigmentation agents; reflectants; detangling/wet combing agents; film forming polymers; humectants; amino acid agents; antimicrobial agents; allergy inhibitors; anti-acne agents; anti-aging agents; anti-wrinkling agents, antiseptics; analgesics; antitussives; antipruritics; local anesthetics;



anti-hair loss agents; hair growth promoting agents; hair growth inhibitor agents; antihistamines; antiinfectives; inflammation inhibitors; anti-emetics; anticholinergics; vasoconstrictors; vasodilators; wound healing promoters; peptides, polypeptides and proteins; deodorants and anti-perspirants; medicament agents; skin emollients and skin moisturizers; skin firming agents, hair conditioners; hair softeners; hair moisturizers; vitamins; tanning agents; skin lightening agents; antifungals; depilating agents; shaving preparations; external analgesics; perfumes; fragrances counterirritants; hemorrhoidals; insecticides; poison ivy products; poison oak products; burn products; anti- diaper rash agents; prickly heat agents; make-up preparations; vitamins; amino acids and their derivatives; herbal extracts; retinoids; flavenoids; sensates; anti-oxidants; skin conditioners; hair lighteners; chelating agents; cell turnover enhancers; coloring agents; pigments; sunscreens and mixtures thereof.